

**REMARKS**

Claims 1-20 are all the claims presently pending in the application. Claims 1-3 are amended to more clearly define the invention. Claims 1-10 are independent.

Applicant appreciates the courtesies extended to the Applicant's representative during the personal interview on May 26, 2004. During the personal interview, Applicant's representative explained that the applied reference does not teach or suggest the features of the present invention including an intermediary.

Applicant notes that, notwithstanding any claim amendments later during prosecution, Applicant's intent is to encompass equivalents of all claim elements.

Claims 1-20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the Rosen reference (U.S. Patent No. 6,081,790).

This rejection is respectfully traversed in the following discussion.

**I. THE CLAIMED INVENTION**

A first exemplary embodiment of the claimed invention, as defined by independent claim 1, is directed to a merchandise transaction method in an on-line shopping system. The method includes an intermediary receiving information about an electronic mall keeper to which a user desires a transaction, information about commodities to be purchased by the user, and a packet and executing an order and payment of commodities to an electronic mall keeper in behalf of the user, and the intermediary receiving a secret decryption key for the packet transmitted from the user in exchange of the commodities and then obtaining a credit card number of the user by deciphering the packet cipher with the secret key.

A second exemplary embodiment of the claimed invention, as defined by independent

claim 2, is directed to a merchandise transaction method in an on-line shopping system. The method includes, at a first transaction between a user which desires to purchase commodities and an intermediary, an intermediary receiving information about an electronic mall keeper to which the user desires a transaction, information about commodities to be purchased by the user, and a packet and executes an order and payment of commodities to an electronic mall keeper in behalf of the user, the intermediary receiving a secret decryption key for the packet transmitted from the user in exchange of the commodities and then obtains a credit card number of the user by deciphering the packet cipher, the intermediary recording a credit card number of the user acquired through decryption of the packet, at the second or later transaction between the user which desires to purchase commodities and the intermediary, the intermediary receiving information about an electronic mall keeper to which the user desires transaction and information about commodities to be purchased by the user and then executing an order and payment of the commodities to an electronic mall keeper in behalf of the user, and the intermediary acquiring a credit card number of the user based on the intermediary recording.

A third exemplary embodiment of the claimed invention, as defined by independent claim 5, is directed to an intermediary information processing system which intermediates between a user and an electronic mall keeper in an on-line shopping system. The system includes a merchandise order receiver for receiving an order of a commodity from a user, the commodity order including information about a desired electronic mall keeper and information about a commodity to be purchased, a packet receiver for receiving a packet transmitted by the user in the merchandise order by the merchandise order receiver, a merchandise order transmitter for ordering the commodity by specifying the intermediary as a

merchandise shipping destination to the electronic small keeper, based on information received by the merchandise order receiver, a credit card number notifier for notifying the electronic mall keeper of the credit card number of the intermediary to pay for a merchandise order by the merchandise order transmitter, a merchandise receiver for receiving the commodity shipped by the electronic mall keeper, a merchandise shipper for shipping the commodity received by the merchandise receiver to the user, a secret decryption key receiver for receiving a secret decryption key transmitted from the user, in exchange of reception of the commodity, and a cash/commission receiver for acquiring a credit card number by deciphering the packet cipher with the secret decryption key received by the secret decryption key receiver and then receiving a cash and commission of the commodity with the credit card number.

Conventional on-line shopping methods and systems require the customer and merchant (e.g., electronic mall keeper) to trust each other. Specifically, one conventional method and system requires the user to transmit the user's credit card number to the merchant and then wait for the arrival of the ordered commodity. In this instance, the user is required to trust the merchant to deliver the ordered commodity and not to use the credit card number in an unauthorized transaction.

Another conventional method and system is a collect-on-delivery system where the user is not required to pay the merchant until after the user actually receives the ordered commodity. However, this requires the merchant to trust the user to actually pay for the commodity even though the user has already received the commodity.

In stark contrast and as explained at the personal interview, the present invention solves these problems by providing methods and systems which provide an intermediary

between the user and the merchant. In this manner, the user can do on-line shopping without directly bargaining or verifying the honesty of a particular merchant and merchants can avoid the risk of a user that does not pay for received merchandise.

## **II. THE PRIOR ART REJECTION**

Regarding the rejection of claims 1-10 (20???), the Examiner alleges that the Rosen reference teaches the claimed invention.

Firstly, Applicant notes that the Examiner's rejection is an exact copy of the rejection that the Examiner presented in the September 29, 2003 Office Action and objects to the Examiner not furthering prosecution of the application.

In paragraph 3 of the currently outstanding Office Action, the Examiner indicates that only claims 1-10 are rejected. This contradicts paragraph 4 of the currently outstanding Office Action which appears to reference claims 1-20. The Examiner appears to have overlooked the fact that Applicant added claims 11-20 in the December 29, 2003 Amendment and, therefore, failed to update the number of claims after cutting and pasting the rejection from the September 29, 2003 Office Action into the currently outstanding Office Action.

Indeed, the only differences between the rejection in the September 29, 2003 Office Action and the currently outstanding Office Action is that the Examiner appears to have "updated" the rejection only for purposes of replacing the reference to "Rowney et al." with a reference to "Rosen" and replacing the reference to "fig. 1C, 2, 3, column 13, lines 8-16, lines 63)" (sic) from the Rowney et al. reference with a reference to "figs. 1, 6, column 7 line 9 to 8 lines 50)" (sic) from the Rosen reference.

The Examiner's cut and pasted rejection even includes the same misspelled words

from the September 29, 2003 Office Action. For example, the cut and pasted rejection from both Office Action recites “an electronic mail keeper in behalf of (sic). . . .”

Of even more concern, since the Examiner obviously merely cut and pasted the rejection from the September 29, 2003 Office Action into the currently outstanding Office Action, the Examiner’s rejection improperly references claim language that is no longer present in the application. In particular, the Examiner’s cut and pasted rejection continues to recite “a first step” and a “second step” which language was deleted from the claims by the December 29, 2003 Amendment.

Thus, Applicant is not confident that the Examiner fully considered the December 29, 2003 Amendment.

Moreover, the Examiner’s alleged significance of the Rosen reference is murky, at best, as the Office Action did not explain the pertinence of this reference to the specific elements which are recited by the claims being rejected, as required by M.P.E.P. § 707.5. Rather, the Examiner merely states that “Rosen reference teaches [the language of claim 1 before the December 29, 2003 Amendment].” The Examiner’s statement completely fails to address the features of the invention which are recited by the currently pending claims.

The Examiner’s rejection also fails to comply with 37 C.F.R. §1.104(c)(2) which requires that “the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” In this case, not only has the Examiner failed to cite the particular portion of the Rosen reference which may have been relied upon, but the Examiner has also failed to clearly explain the pertinence of the Rosen reference to each rejected claim.

For example, during the personal interview on December 22, 2003 and in the remarks

of the December 29, 2003 Amendment, the Applicant consistently stressed the feature in the claims of the intermediary. The March 4, 2004 Office Action does not point out "the particular part relied on" with respect to the claimed intermediary.

To assist Applicants' understanding, Applicants hereby respectfully request that the Examiner comply with the requirements of M.P.E.P. § 707.5 by explaining in detail the correspondence between the specific features recited by claims 1-20 and the particular portions of the Rosen reference.

Note that MPEP 707.05 states:

"During the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims. When such prior art is cited, its pertinence should be explained"

To further the prosecution of this application, however, Applicant has closely reviewed the Rosen reference to address the clear differences between the Rosen reference and the claims.

As explained during the May 26, 2004, personal interview, the Rosen reference does not teach or suggest the features of the present invention including an intermediary.

Indeed, the Rosen reference does not teach or suggest anything at all regarding an intermediary, let alone a method that includes an intermediary receiving information about an electronic mall keeper to which a user desires transaction, information about commodities to be purchased by the user, and a packet and executing an order and payment of commodities to an electronic mall keeper on behalf of the user; and an intermediary receiving a secret decryption key for the packet transmitted from the user in exchange of the commodities and

then obtaining a credit card number of the user by deciphering the packet cipher, as recited, for example, by independent claim 1.

The Rosen reference also does not teach or suggest anything at all regarding an intermediary information processing system which intermediates between a user and an electronic mall keeper in an on-line shopping system. The intermediary information processing system including a merchandise order receiver for receiving an order of a commodity from a user, the commodity order including information about a desired electronic mall keeper and information about a commodity to be purchased, a packet receiver for receiving a packet transmitted by the user in the merchandise order by the merchandise order receiver, a merchandise order transmitter for ordering the commodity by specifying the intermediary as a merchandise shipping destination to the electronic small keeper, based on information received by the merchandise order receiver, a credit card number notifier for notifying the electronic mall keeper of the credit card number of the intermediary to pay for a merchandise order by the merchandise order transmitter, a merchandise receiver for receiving the commodity shipped by the electronic mall keeper, a merchandise shipper for shipping the commodity received by the merchandise receiver to the user, a secret decryption key receiver for receiving a secret decryption key transmitted from the user, in exchange of reception of the commodity, and a cash/commission receiver for acquiring a credit card number by deciphering the packet cipher with the secret decryption key received by the secret decryption key receiver and then receiving a cash and commission of the commodity with the credit card number, as recited by, for example, independent claim 5.

Rather, the Rosen reference discloses a system and method for secure presentation and payment over open networks. In particular, the Rosen reference discloses "a system that

enables a merchant to securely present invoices or past due notices to a customer over an open network like the Internet.” (Col. 1, lines 47-49).

Indeed, in complete contrast to the present invention, the Rosen reference specifically points out that the system and method avoids the use of intermediaries.

“It is an object of the invention to provide a secure system using trusted agents that enables presentment of invoices and past due notices from merchant to customer without any intermediaries.” (Emphasis added, col. 1, lines 64-67).

The Examiner cites Figs. 1 and 6 and column 7, line 9 to column 8, line 50 of the Rosen reference in what appears to be an attempt to support the Examiner’s allegation that the Rosen reference discloses the features of the present invention.

The Examiner cites Fig. 1 and 6 or in column 7, line 9 to column 8, line 50 of the Rosen reference without pointing out where in that vast portion of the Rosen reference may be found any disclosure of an intermediary. Applicant submits that the Examiner did not particularly point out where in the Rosen reference may be found any disclosure of an intermediary because the Rosen reference does not disclose an intermediary.

Lastly, not only does the Rosen reference not teach or suggest an intermediary, but the Rosen reference also has absolutely nothing to do with an online-shopping transaction. Rather, the Rosen reference is only concerned with processing invoices and payments.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-10 (1-20????).

### **III. FORMAL MATTERS AND CONCLUSION**

Applicant again notes that the Examiner has again failed to indicate receipt of the certified copy of the priority document that was filed on February 18, 2001. Applicant respectfully requests that the Examiner indicate receipt of the certified copy of the priority document that was filed on February 18, 2001.

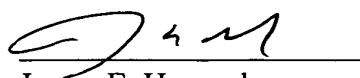
In view of the foregoing amendments and remarks, and in light of the explanation provided to the Examiner during the May 26, 2004 personal interview, Applicant respectfully submits that claims 1-20, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 4/2/04

  
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